

## **REMARKS**

Applicants have amended claims 1-10, 12-18, 20-23, and 25-29, and have cancelled claims 11, 19, and 24, during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

Claim 10 has been amended to be rewritten in independent form to include the limitations of claim 1 and is otherwise the same claim 10 as was originally filed.

The Examiner rejected claim 1 under 35 U.S.C. § 101 because the claim allegedly does not appear to comply with the Bilski test where the method claim is verified to clearly tie the subject matter to another class of invention or perform the transformation test.

The Examiner rejected claims 1-5, 10-11, 15, 20-24, 26-27 and 29 under 35 U.S.C. § 102(b) as allegedly being anticipated by Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002.

The Examiner rejected claims 6-9, 12-14, 16-19, 25 and 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002, in view of Schneider et al. (hereinafter Schneider) U.S. Patent Publication No. 2002/0156866 filed April 19, 2001.

The Examiner rejected claims 8-9 and 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002, in view of Ma et al. (hereinafter Ma) U.S. Patent No. 6,731,315 filed Nov. 30, 1999.

Applicants respectfully traverse the § 101, § 102 and § 103 rejections with the following arguments.

**35 U.S.C. § 101: Claim 1**

The Examiner rejected claim 1 under 35 U.S.C. § 101 because the claim allegedly does not appear to comply with the Bilski test where the method claim is verified to clearly tie the subject matter to another class of invention or perform the transformation test.

In response, Applicant notes that the United States Supreme Court in *Bilski et al. v. Kappos*, No. 08-964, decided June 28, 2010, rejected the Bilski machine-or-transformation test as the exclusive method of determining patentability under 35 U.S.C. § 101.

Therefore, the rejection of claim 1 under 35 U.S.C. § 101 is moot.

**35 U.S.C. § 102(b): Claims 1-5, 10-11, 15, 20-24, 26-27 and 29**

The Examiner rejected claims 1-5, 10-11, 15, 20-24, 26-27 and 29 under 35 U.S.C. § 102(b) as allegedly being anticipated by Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002.

Since claims 11 and 24 have been cancelled, the rejection of claims 11 and 24 under 35 U.S.C. § 102(b) is moot.

Applicants respectfully contend that Carro does not anticipate claim 1, because Carro does not teach each and every feature of claim 1.

For example, Carro does not teach the feature: “presenting said retrieved data visually to a visually impaired person or orally to a blind person on the user system, wherein said presenting said retrieved data visually is configured to enable the visually impaired person to see said retrieved data, and wherein said presenting said retrieved data orally is configured to enable the blind person to hear said retrieved data”.

Based on the preceding arguments, Applicants respectfully maintain that Carro does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claims 2-5, 10, 15, 20-23, 26-27 and 29 depend from claim 1, Applicants contend that claims 2-5, 10, 15, 20-23, 26-27 and 29 are likewise in condition for allowance.

In addition with respect to claim 10, Carro does not teach the feature: “wherein the electronic copy of the document is an exact replica of the physical document”.

The Examiner argues: “With respect to **dependent claim 10**, Carro teaches the method wherein the electronic copy of the document is an exact replica of the physical document (see Para 127).”

In response, Applicant respectfully contends that Carro, Par. 127 is totally silent as to the electronic document.

Accordingly, Carro does not anticipate claim 10 under 35 U.S.C. § 102(b).

In addition with respect to claim 15, Carro does not teach the feature: “wherein said presenting comprises presenting said retrieved data orally to the blind person on the user system, and wherein said retrieving, from the electronic copy of the document, data related to the selected part of the physical document comprises:

identifying and locating information and/or services associated with the selected part of the physical document;

retrieving said information and/or services; and

audibly playing said information and/or services on the user system”.

Accordingly, Carro does not anticipate claim 15 under 35 U.S.C. § 102(b).

In addition with respect to claim 22, Carro does not teach the feature: “wherein said user system is connected to a communication network comprising a plurality of servers, and wherein the information and/or services associated with said physical document are located on each server of said plurality of servers”.

Accordingly, Carro does not anticipate claim 22 under 35 U.S.C. § 102(b).

**35 U.S.C. § 103(a): Claims 6-9, 12-14, 16-19, 25 and 28**

The Examiner rejected claims 6-9, 12-14, 16-19, 25 and 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002, in view of Schneider et al. (hereinafter Schneider) U.S. Patent Publication No. 2002/0156866 filed April 19, 2001.

Since claim 19 has been cancelled, the rejection of claim 19 under 35 U.S.C. § 103(a) is moot.

Since claims 6-9, 12-14, 16-18, 25 and 28 depend from claim 1 which Applicants have argued *supra* to not be anticipated by Carro under 35 U.S.C. § 102(b), Applicants maintain that claims 6-9, 12-14, 16-18, 25 and 28 are not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 7 with inclusion of the limitations of claim 6 from which claim 7 depends, Carro in view of Schneider does not teach the feature:

“wherein said presenting comprises presenting said retrieved data orally to the blind person on the user system, and wherein said presenting said retrieved data orally comprises:

extracting text data from said data;

converting said text data into data that can be audibly read ...

wherein said converting said text data into data that can be electronically read comprises: audibly reading, to the blind person on the user system, said text data by means of a text-to-speech system”.

The Examiner cites the text-to-speech converter disclosed in Schneider, Par. [0078].

In response, Applicants note that Schneider, Par. [0078] discloses a text-to-speech converter within a generic description of the resources available by the client 110, but does not disclose how the text-to-speech converter may be used for Schneider's invention. However, Schneider, Par. [0078] discloses both a speech-recognition unit and a text-to-speech converter which suggests that the text-to-speech converter is intended to convert text that is generated from output generated by the speech-recognition unit from spoken data, and thus differs from the language in claim 7 which recites that the text data that is converted into data that can be audibly read is obtained from the electronic document and thus not from spoken data.

Therefore, Schneider, Par. [0078] does not teach the preceding feature of claim 7.

Accordingly, claim 7 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 8, Carro in view of Schneider does not teach the feature: "wherein said presenting comprises presenting said retrieved data visually to the visually impaired person on the user system, and wherein said presenting said retrieved data visually comprises: magnifying the retrieved data on a screen such that the magnified retrieved data can be visually read by the visually impaired person".

Applicant asserts that neither Carro nor Schneider disclose anything related to a visually impaired person.

Furthermore, neither Carro nor Schneider disclose magnification of data.

Accordingly, claim 8 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 9, Carro in view of Schneider does not teach the feature: “wherein said magnifying the retrieved data on the screen comprises: magnifying on the screen the electronic copy of the selected part of the physical document”.

Applicant asserts that neither Carro nor Schneider disclose magnification of data.

Accordingly, claim 9 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 12, Carro in view of Schneider does not teach the feature: “wherein said presenting comprises presenting said retrieved data visually to the visually impaired person on the user system, and wherein said presenting the retrieved data visually comprises: enhancing on a screen the electronic copy of the selected part of the physical document to match a preferred reading view of the visually impaired person”.

Applicant asserts that neither Carro nor Schneider disclose anything related to a visually impaired person.

In addition, Carro in view of Schneider does not disclose “enhancing on a screen the electronic copy of the selected part of the physical document to match a preferred reading view of the visually impaired person”.

Accordingly, claim 12 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 13, Carro in view of Schneider does not teach the feature: “wherein said identifying the physical document comprises: reading, by means of a



barcode reader, a document identifier printed on said physical document at a predefined position”.

The Examiner argues: “Schneider shows an example of reading bar codes with the bar-code printed on the medium (See Figure 10-6 and Para 108) and a system that converts text – to – speech (see Para 78). The barcodes recognize symbols to retrieve information on the internet. Schneider teaches recognition of an address with media with an attachment to an image read from the medium where the media can be read via the text-to speech system (See Para 113)”.

In response, Applicant asserts that Schneider, Pars. [0078], [0108], and [0113] are totally silent as to reading, by means of a bar code reader, a document identifier printed on the physical document at a predefined position.

Accordingly, claim 13 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 14, Carro in view of Schneider does not teach the feature: “wherein said identifying a page in said physical document comprises: reading, by means of a barcode reader, a page identifier printed on said page at a predefined position”.

The Examiner argues: “Schneider shows an example of reading bar codes with the bar-code printed on the medium (See Figure 10-6 and Para 108) and a system that converts text – to – speech (see Para 78). The barcodes recognize symbols to retrieve information on the internet. Schneider teaches recognition of an address with media with an attachment to an image

read from the medium where the media can be read via the text-to speech system (See Para 113)”.

In response, Applicant asserts that Schneider, Pars. [0078], [0108], and [0113] are totally silent as to reading, by means of a bar code reader, a page identifier printed on the page of the physical document at a predefined position.

Accordingly, claim 14 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 16, Carro in view of Schneider does not teach the feature: “wherein said information associated with the selected part of the physical document comprises a description of graphical data related to the selected part of the physical document, and wherein said audibly playing comprises audibly playing said description of said graphical data to the blind person on the user system”.

Applicant asserts that neither Carro nor Schneider disclose anything related to a blind person.

Furthermore, neither Carro nor Schneider disclose “audibly playing comprises audibly playing said description of said graphical data to the blind person on the user system”.

Accordingly, claim 16 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 17, Carro in view of Schneider does not teach the feature: “wherein said presenting comprises presenting said retrieved data orally to the blind

person on the user system, and wherein said identifying and locating an electronic copy of the identified document comprises:

identifying and locating information associated with the physical document;

retrieving said information; and

audibly playing said information to the blind person on the user system”.

Applicant asserts that neither Carro nor Schneider disclose anything related to a blind person.

Accordingly, claim 17 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 18, Carro in view of Schneider does not teach the feature:

“wherein the information associated with the physical document comprises speech instructions related to the physical document;

wherein the speech instructions comprise speech instructions for locating positions of bar codes on pages of the physical document; and

wherein said audibly playing comprises audibly playing, to the blind person on the user system, said speech instructions for locating said positions of bar codes on pages of the physical document”.

Accordingly, claim 18 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

In addition with respect to claim 25, Carro in view of Schneider does not teach the feature: “wherein said physical document comprises Braille indications”.

Applicant asserts that neither Carro nor Schneider mentions Braille.

Accordingly, claim 25 is not unpatentable over Carro in view of Schneider under 35 U.S.C. § 103(a).

**35 U.S.C. § 103(a): Claims 8-9 and 12**

The Examiner rejected claims 8-9 and 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 2002/0087598 published July 4, 2002, in view of Ma et al. (hereinafter Ma) U.S. Patent No. 6,731,315 filed Nov. 30, 1999.

Applicants respectfully contend that Ma cannot be used as prior art in rejecting claims of the present patent application, because 35 U.S.C. § 103(c) recites: “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”.

First, the Ma patent is being considered by the Examiner as prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e), because the Ma patent was issued and published on May 4, 2004 which is after the filing date of April 15, 2004 of the present patent application.

Second, both the subject matter of Ma patent and the claimed invention of the present patent application were, at the time the invention was made, owned by International Business Machines Corporation or subject to assignment by International Business Machines Corporation.

Accordingly, Applicants respectfully maintain that Ma cannot be used as a prior art reference to reject claims 8-9 and 12 under 35 U.S.C. 103 via 35 U.S.C. 102(e).

Therefore, claims 8-9 and 12 are not unpatentable under 35 U.S.C. § 103(a) over Carro in view of Ma.

### CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM). The Attorney's reference number for this case is END-8841.

Date: July 6, 2010

/ Jack P. Friedman /  
Jack P. Friedman  
Registration No. 44,688

Customer No. 30449  
Schmeiser, Olsen & Watts  
22 Century Hill Drive - Suite 302  
Latham, New York 12110  
Telephone (518) 220-1850  
Facsimile (518) 220-1857  
E-mail: jfriedman@iplawusa.com